Remarks

Applicants request reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

Claims 13-15 have been amended. Claims 16 through 20 have been cancelled without prejudice to or disclaimer of the subject matter recited therein.

New claims 21-25 have been added. No new matter has been added.

Claims 1-15 and 21-25 are pending in the present application. Claims 1, 7, 11, and 21 are the independent claims.

The Office Action objects to dependent claim 6 because of informalities. Specifically, the Office Action objects to claim 6 because claim 6 depends from independent claim 7. MPEP 608.01(m) states "Claims **should preferably** be arranged in order of scope so that the first claim presented is least restrictive. All dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable" (emphasis added). Thus, the MPEP indicates that, while arranging the claims in order of scope is **preferable**, it is not required. Applicants respectfully submit that no correction is **required** at this time. Rather, because claim 6 depends upon claim 7, rearranging the claims in order of scope at this time would require the renumbering of a significant number of the claims, as well as amendments to the claims to reflect the renumbering of base claims. For at least these reasons, Applicants submit that rearranging the claims is not practical at this stage of prosecution. Accordingly, the claims should be rearranged after allowance.

Claims 13-20 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

By this Amendment, claims 13-15 have been amended to clear up any possible indefiniteness issues, and claims 16-20 have been cancelled.

Accordingly, Applicants respectfully submit that the rejection of claims 16-20 is moot, and request favorable reconsideration and withdrawal of the Examiner's §112 rejections of claims 13-15.

Claims 13-20 stand rejected under 35 U.S.C. §101, and the Office Action alleges that "the claimed invention is directed to non-statutory subject matter."

Claims 13-15 have been amended to recite limitations of the controller and, thus, are directed to statutory subject matter. Claims 16-20 have been cancelled. Thus, Applicants respectfully submit that the rejection of claims 16-20 is moot.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 13-15 under 35 U.S.C. §101.

Claims 1-20 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application Publication No. 2001/0055172 to Yip et al. All rejections are respectfully traversed.

Independent claim 1 recites, *inter alia*, determining whether the location of an identified defect is within a predetermined window of another identified defect location on the media surface; and if the location is within the predetermined window, characterizing the defects in the window as a scratch. As described in the originally filed Specification, for example, at least at page 6, lines 24-27, a window may be characterized both radially (in cylinders) and circumferentially (in bytes).

Independent claim 7 recites, *inter alia*, determining whether one or more defect locations lies within a predetermined window of another defect location; assigning a unique scratch index to each defect location within the predetermined window; and generating a scratch index table associating a scratch index with each defect location.

Independent claim 11 recites, *inter alia*, a scratch index table in the memory having a unique index entry for each identified defect location on the data storage media and an associated scratch index entry for each defect location.

MPEP 2131 states "'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.'" *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, in order to anticipate a claim, a single reference must teach every element of a claim.

At page 4, the Office Action contends that Yip et al. teaches "determining whether the location of an identified defect is within a predetermined window of another identified defect

location on the media surface", as recited in independent claim 1, and relies upon paragraph [0022] of Yip et al. in support of this contention. This contention is respectfully traversed.

Paragraph [0022] of Yip et al. merely discusses that tracks are grouped into zones based on the rates at which data is written, and then sectors are analyzed zone by zone. All defective sectors in the same zone are grouped into one or more clusters. At page 4, the Office Action contends that Yip et al. teaches "determining whether the location of an identified defect is within a predetermined window of another identified defect location on the media surface", as recited in independent claim 1, and relies upon paragraph [0022] of Yip et al. in support of this contention. This contention is respectfully traversed.

Paragraph [0022] of Yip et al. merely discusses that tracks are grouped into zones based on the rates at which data is written, and then sectors are analyzed zone by zone. All defective sectors in the same zone are grouped into one or more clusters. Thus, the groupings of Yip et al. are based on 1) the speed at which data is written and 2) whether or not a defect exists. Yip et al., however, fails to discuss or suggest a predetermined window, or the determination of whether an identified defect location is within a predetermined window of another identified defect, as recited in independent claim 1.

At page 4, the Office Action contends that Yip et al. teaches that "if the location is within the predetermined window, characterizing the defects in the window as a scratch" as recited in independent claim 1. Paragraph [0022] of Yip et al. is cited in support of this contention, and alleged to teach that "adjacent defects [are] grouped together as [a] cluster." This contention is respectfully traversed.

Applicants respectfully submit that it is not adjacent defects within a predetermined window that are grouped together as a cluster in Yip et al. Rather, according to paragraph [0022] of Yip et al., "tracks may be grouped into zones with data written at different rates for the various zones" and "all defective sectors in the same zone are then grouped into one or more clusters." Thus, Yip et al. merely teaches that all defective sectors are grouped into clusters according to data write rate. Yip et al. fails to teach or suggest that defects located within the predetermined window around another identified window are characterized as a scratch.

At page 5, the Office Action again contends that Yip et al. teaches "determining whether one or more defect locations lies within a predetermined window of another defect location", as

recited in independent claim 7, and cites paragraph [0022] of Yip et al. in support of this contention. This contention is respectfully traversed.

As discussed above with respect to claim 1, paragraph [0022] of Yip et al. merely discusses that tracks are grouped into zones based on the rates at which data is written, and then sectors are analyzed zone by zone. All defective sectors in the same zone are grouped into one or more clusters. Thus, the groupings of Yip et al. are based on 1) the speed at which data is written and 2) whether or not a defect exists. Yip et al., however, fails to discuss or suggest a predetermined window, or the determination of whether an identified defect location is within a predetermined window of another identified defect, as recited in independent claim 7.

At page 5, the Office Action contends that Yip et al. teaches "assigning a unique scratch index to each defect location within the predetermined window", as recited by independent claim 7, and relies upon Table 2 of Yip et al. in support of this contention. This contention is respectfully traversed.

Paragraph [0025] of Yip et al. states that "The set of parameters [shown in Table 2] describing the pattern is stored in a second defect table. This one entry in the second defect table replaces the six entries in the first defect table." While Table 2 of Yip et al. does illustrate parameters unique to specific scratch, it eliminates reference to each defect location within a predetermined window. Further, the first defect table of Yip et al. (Table 1) merely provides a list of defect entries from which a pattern is derived and recorded in Table 2. Thus, Yip e al. fails to discuss or suggest "assigning a unique scratch index to each defect location within the predetermined window" as recited in independent claim 7.

At page 6, the Office Action contends that Yip et al. teaches "generating a scratch index table associating a scratch index with each defect location", as recited in independent claim 7, and paragraph [0025] of Yip et al. is cited in support of this contention. This contention is respectfully traversed.

Paragraph [0025] of Yip et al. states "The set of parameters describing the pattern is stored in a second defect table. This one entry in the second defect table thus replaces the six entries in the first defect table." Thus, Yip et al. merely discusses that the entries for six defects making up a scratch can be condensed into a pattern describing the scratch and stored in a single entry in a second defect table. Yip et al. provides no teaching or suggest that a scratch index

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table is generated, or that a scratch index is associated with each defect location. Rather, Yip et al. eliminates references to each defect location in Table 2.

At page 7, the Office Action contends that Yip et al. teaches "a scratch index table in the memory having a unique index entry for each identified defect location on the data storage media and an associated scratch index entry for each defect location", as recited in independent claim 11, and contends that Yip et al. teaches this feature at Table 2 and paragraph [0024]. This contention is respectfully traversed.

Paragraph [0024] of Yip et al. merely describes Table 1, which represents defect entries in the first defect table. From these defect entries, a pattern is derived from the location of the defective sectors belonging to the same cluster, and the derived pattern is stored in Table 2. As discussed previously, Table 2 describes each scratch with a single entry. Further, Table 1 of Yip et al. provides no teaching or suggestion of any type of scratch index entry. Accordingly, Applicants respectfully submit that Yip et al. fails to teach or suggest a scratch index table, as recited in independent claim 11.

Accordingly, favorable reconsideration and withdrawal of the rejection of independent claims 1, 7, and 11 under 35 U.S.C. § 102 are respectfully requested.

In view of the foregoing, Applicant respectfully submits that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested.
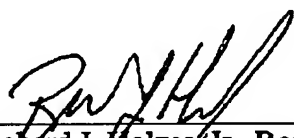
New claims 21-25 have been added to set forth the invention in varying scope. New independent claim 21 recites "characterizing defects in a medium as belonging to one or more scratches in the medium using a scratch index table." Applicants respectfully submit that new independent claim 21 and new dependent claims 22-25 patentably distinguish over the cited art for at least the reasons discussed above.

Applicants believe that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.

There being no further outstanding objections or rejections, it is submitted that the present application is in condition for allowance. An early action to that effect is courteously solicited.

Respectfully submitted,

_____12-15-06_____
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